



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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In re Patent Application of :

Randall B. METCALF

Serial No.: 08/749,766

Filed: November 20, 1996

Group Art Unit: 2644

Examiner: M. HARVEY

For: SOUND SYSTEM AND METHOD FOR CAPTURING AND REPRODUCING  
SOUNDS ORIGINATING FROM A PLURALITY OF SOUND SOURCES

Assistant Commissioner for Patents

BOX: AF

Washington, D.C. 20231

REPLY BRIEF

This is Applicant's Reply Brief in connection with the above-captioned patent application. The Examiner's Answer (hereinafter the "Answer"), mailed on July 9, 2001, raised new issues that were not specifically addressed during the prosecution of the present application. It is to these issues that the Appellant directs his Reply Brief.

Claims 1, 2, 4-10, 12-15, 17-19, and 21-55 remain rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 3,710,034 to Murry (hereinafter referred to as "Murry") in view of U.S. Patent No. 5,315,060 to Paroutaud (hereinafter referred to as "Paroutaud").

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## **I. Murry Discloses Mixing Audio Signals**

The Examiner asserts that the “Murry reference does disclose separately receiving sounds.” Answer at p. 3. However, this is directly contradicted later in the Answer, when the Examiner states that “[t]he examiner agrees that the sound being received [is] initially mixed in the Murry reference.” *Id.* at p. 4. Appellant respectfully submits that this confusion over the functions performed in Murry underscores the deficiencies of the rejection.

Murry actually teaches four microphones located in separate corners of a room. See Fig. 3, reference numbers 31-34; c. 8, ll. 32-34. Further, a plurality of sound sources are located in the room. See Fig. 3, references A, B, C, c. 8, ll. 32-48. Each microphone receives sound from each sound source A, B, and C, thereby mixing the sound. Thus, sound from each of the sound sources is mixed from the beginning in the system disclosed in Murry. This is contrary to the recitations of the pending claims.

## **II. The Combination of Murry and Paroutaud is Improper**

The Answer still provides no objective motivation to combine Murry and Paroutaud. Rather, the Answer continues to include merely conclusive statements regarding the alleged ability to combine Murry and Paroutaud. To establish a *prima facie* case of obviousness, an rejection must provide an objective motivation to combine the reference. As the Court of Appeals for the Federal Circuit has stated:

“[The PTO] can satisfy [the obviousness] burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *Tec Air Inc. v. Denso Mfg. Michigan, Inc.*, 52 U.S.P.Q.2d 1294, 1298

(Fed. Cir. 1999)(citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).<sup>1</sup>

The Answer has provided no teaching for such a combination, let alone any objective motivation. The only teaching to combine the teachings of Murry and Paroutaud is found in Appellant's application. The Answer has impermissably used the disclosure of Appellant's application to construct the current rejection.

Furthermore, the Answer fails to address any of the issues raised by Appellant. In the Appeal Brief filed on March 26, 2001 (hereinafter the "Appeal Brief"), Appellant noted that there is no motivation to combine the references, as it would frustrate both the purpose of Murry and the purpose of Paroutaud Appeal Brief, p. 15. In response, the Answer states that "[t]he appellant's argument is not persuasive because Paroutaud reference was applied to show that sounds are produced by the plurality of sound source, an amplification network, and a dynamic control means are well know in the art." Answer, p. 5 This statement neither addresses the Appellants argument nor provides a motivation for the combination of Paroutaud and Murry.

The Appeal Brief also noted that the rejections improperly alleged that combinations could be made Appeal Brief, p. 9. The Answer merely restates that "it would have been obvious to combine [Murry and Paroutaud]... because in reproduction of music, each microphone could detect the sound of each instrument" (emphasis added). Appeal Brief, p. 4. The only reference to this argument in the Answer is that "[t]he Examiner has used 'could' to show that combining the two references would have been an alternative to accomplishing a certain effect." Appeal Brief, p. 4. These statements are still legally improper and the rejection of the claims, including

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<sup>1</sup> See also, *In re Fitch*, 23 U.S.P.Q. 1780 (Fed. Cir. 1992); *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 221 U.S.P.Q. 929 (Fed. Cir. 1992).

the discussion in the Answer, still fails to address what the references “would” teach, not what they “could” teach.

The Answer asserts that “[t]he appellant’s argument is not persuasive because as described above, the prior art read on the claimed invention” Answer, p. 5. However, this statement is merely a conclusion, and does not provide a rational for a combining the references.

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### **III. Breadth of Claims**

Finally, the Answer briefly asserts in the section entitled “Conclusion” that the independent claims are broad and “read on taking a plurality of tape recorder [sic] into a different room and separately recording the sound from each room and replaying the sounds.” Answer, p. 6. This assertion is not well founded, as the mere fact that a claim is broad does not preclude patentability. The breadth of a claim is only relevant as to the prior art applied to that claim.

Further, the recitation of the alleged system of tape recorders (an issue which was never previously raised during the prosecution of the this application) is not a proper objection or rejection. There is no objective evidence provided regarding these hypothetical tape recorders. Further, there is not even an allegation, let alone any objective evidence, regarding such a hypothetical system of tape recorders has “dynamic control means,” as recited in the claims, or has customization features as are recited in the claims at issue. No evidence, objective or otherwise, has been provided that such elements are found in these hypothetical tape recorders.

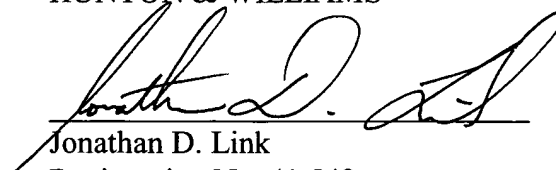
**CONCLUSION**

For at least the foregoing reasons, the rejections of claims 1, 2, 4-10, 12-15, 17-19, and 21-55 should be reversed.

Respectfully submitted,

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